Supreme Court, U.S.
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No.

In The Supreme Court of the United States October Term, 1995

VAN KLASSENS, INC.
AND
ROBERT LUKINGBEAL,

Petitioners,

v.

IMAGINEERING, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

I. Whether it is contrary to federal patent law for the designs of twenty-two unpatented products to be monopolized in perpetuity as inherently distinctive trade dress.

II. Whether a competitor that labels its furniture and advertising with its own source-indicative trademark can be assessed punitive damages under state unfair competition law for selling product designs passed into the public domain by operation of federal patent law.

STATEMENT PURSUANT TO RULE 29.1

The only parties to this action are those listed in the caption. Van Klassens, Inc. has no parent or subsidiary companies.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioners, Van Klassens Inc. and Robert Lukingbeal, (hereinafter "Van Klassens"), respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit (hereinafter "Federal Circuit") in this case.

OPINIONS BELOW

The opinion of the Federal Circuit is reported at 34 USPQ2d 1526 (Fed. Cir. 1995) and is reprinted in the Appendix (*infra*, 1a - 13a). The opinion of the United States District Court for the Southern District of New York is reported at 851 F.Supp. 532 (SDNY 1994) and is reprinted in the Appendix (*infra*, 24a - 40a).

JURISDICTION

The Federal Circuit entered its decision on April 24, 1995. Neither party requested rehearing. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

The statutes involved in this petition are Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), 35 U.S.C. §§ 102, 103 and 253 which provide:

15 U.S.C. § 1125(a) False designations of origin and false descriptions forbidden [Section 43]

(a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which --

> (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
>
> (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

***

35 U.S.C. §102 Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

***

(f) he did not himself invent the subject matter sought to be patented ... .

***

35 U.S.C. § 103 Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. ...

***

35 U.S.C. § 253 Disclaimer

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest

therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

***

STATEMENT OF THE CASE

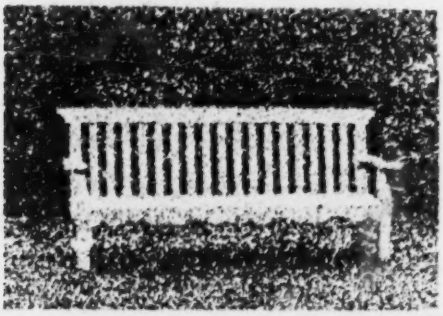
This case enjoined the petitioners from making and selling a rocking chair that is the subject of an invalid and disclaimed design patent, and numerous other pieces of unpatented and unpatentable furniture alleged to have a common trade dress. The injunction was issued by the district court, and stayed and then affirmed by the Federal Circuit. Neither the district court's injunction nor the opinion of the Federal Circuit provide a full, clear and concise description of the trade dress so as to give guidance to either Van Klassens or other competitors in the English garden furniture industry. Thus, the industry has inadequate notice as to what Imagineering considers its property and no guidance as to how to compete in the English garden furniture industry without infringing Imagineering's trade dress. This will impede competition and will result in a proliferation of "trade dress" litigation. Moreover, the injunction is in derogation of the public's right to use product designs that the patent laws make freely available. In *Qualitex Co. v. Jacobson Products Co., Inc.*, 115 S.Ct. 1300 (1995), this Court unanimously recognized that "[i]t is the province of the patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs ... for a limited time, ... after which competitors are free to use the innovation." However, under the Lanham Act, Imagineering has achieved, in essence, a perpetual patent-like monopoly over its unpatented and unpatentable furniture designs.

I. Background

Origins of the furniture designs at issue: Garden furniture of the style at issue in this case has been commonplace, in both the United States and Europe, since at least the turn of the century. The circa 1910 catalogue of John P. White's Pyghtle Works of Bedford England referenced a then-hundred-year-old garden seat, stating:

> This design, illustrated on the following page, and called the "PEACOCK," has always been, and is still,

the favourite pattern, its quiet and unassuming appearance harmonizing with any surroundings.



J.P. White commercialized many designs in the basic style of the "Peacock" garden seat, including white, slatted, wooden chairs and straight and quarter circle settees having slatted backs, slatted seats, scrolled armrests, notched front leg members and winged crest rails. At the turn of the century, furniture of this style was also frequently used by E.L. Lutyens and his collaborator, legendary gardener Gertrude Jekyll.

In approximately 1913, Hans Heistad, a Norwegian landscape architect, built outdoor furniture for the Gribbel family, owners of the Weatherend Estate in Maine. Like the J.P. White furniture, this furniture had slatted backs and seats, and some pieces included scrolled armrests, notched front leg members and winged crest rails.

In 1983-84, William Fisher established Imagineering in Maine, and began manufacturing and selling the Weatherend Estate Furniture line. Imagineering states in its 1992 catalog that "[h]e had one express intent in founding the company: to **recreate**, in all its fineness of detail, the fabulous furniture he discovered at the [Weatherend] estate. [emphasis added]" Imagineering devoted much of its advertising to the fact that its furniture designs are "reproductions" of Hans Heistad's furniture. Imagineering's 1992 catalog further states:

> Those pristine white furnishings captured our imagination, and so Weatherend® Estate Furniture was founded, to **recreate**, in all its fineness of detail, the fabulous furniture found in the gardens of this beautiful residence by the sea.
>
> ***
>
> ... We then affix a brass plaque as a stamp of authenticity and verification that it was expertly crafted in Rockland, Maine.
>
> This plaque is also a sign of assurance - a guarantee that your piece is genuine Weatherend® Estate Furniture...

(emphasis added). In order to designate the source of its reproduction furniture, Imagineering affixes the above-mentioned brass plaque that is stamped with Imagineering's registered trademark, "Weatherend®".

Van Klassens: Van Klassens was founded to produce the same style of furniture that can be seen in England and Scotland. This furniture is sometimes referred to as English garden furniture. Van Klassens rented space for a production facility in 1986. Over a period of approximately 14 months, by a process of trial and error, the designs for Van Klassens' line of furniture were developed. While the designs were sufficiently finalized to produce some early advertisements in April 1987, the furniture was not ready for delivery until August 1987, the date of Van Klassens' first shipment. The Federal Circuit found it persuasive, on the issue of good faith, that Van Klassens developed several pieces of furniture in its furniture line with knowledge of the design of Imagineering's Weatherend line of furniture. App. *infra*, 7a-8a. However, Van Klassens plainly marked its advertisements and its furniture with its own source-indicating trademark and neither the jury, the district court nor the Federal Circuit found any evidence of palming-off. Indeed, Imagineering did not allege that Van Klassens was palming its furniture off as Weatherend furniture.

The dispute between the parties: Imagineering first contacted Van Klassens by letter dated on or about July 13, 1987, asserting alleged potential confusion as to the source of Van Klassens' furniture with Imagineering's furniture. On November 5,

1987, Imagineering threatened Van Klassens with immediate legal action. Van Klassens contacted counsel, E.H. Rayson, Esq., in Knoxville, Tennessee, who responded to Imagineering's charges by letter of November 19, 1987, stating:

> There is no similarity in the names of the two companies. Insofar as we are aware, there are no patents or trade marks involved on behalf of either client. A comparison of the products reveals that the differences between the lines of furniture far exceed any similarity that may exist.... We see no reasonable possibility of confusion with respect to the work of the two companies.
>
> Under the circumstances we know of no right which your client has to appropriate to itself the sole and exclusive right to manufacture and market this general type of furniture.
>
> ... It is our conclusion that our client has every legal right to manufacture and market his product in competition with that manufactured and marketed by your client and others in the industry.

This response went unchallenged for approximately four years. On or about October 14, 1991, Imagineering wrote Van Klassens alleging infringement of U.S. Patent No. Des. 313,320, ("'320 patent"), App. *infra*, 48a - 52a, and resurrecting its stale Lanham Act claims. During these proceedings, the '320 patent was found to be invalid and was dedicated to the public by Imagineering with a disclaimer of patent under 35 U.S.C. § 253. App. *infra*, 53a.

II. Proceedings Below

Imagineering, a Maine corporation, filed suit against Van Klassens on January 30, 1992, in the Southern District of New York. In its first two causes of action, Imagineering alleged that Van Klassens was infringing the '320 patent. Imagineering also alleged that Van Klassens was unfairly competing by infringing

Imagineering's alleged trade dress, that Van Klassens had committed false advertising and that Van Klassens was diluting its trade dress.

Van Klassens answered on March 31, 1992, asserting that the '320 patent was both invalid and not infringed. Van Klassens also denied Imagineering's allegations that it was unfairly competing with Imagineering by infringing its alleged trade dress, denied engaging in false advertising, and denied the dilution charge. As relief, Van Klassens sought, among other things, dismissal of Imagineering's Complaint, a determination by the district court that the case was exceptional pursuant to 35 U.S.C. § 285, and attorneys' fees.

Van Klassens sought to amend its Answer on October 20, 1992, to include a counterclaim seeking a declaration that the '320 patent was invalid and not infringed. Subsequently, Imagineering produced an invoice from its corporate records that reflected that Imagineering had sold two of its rocking chairs more than one year prior to filing its application for the '320 patent; see 35 U.S.C. §102.[1] Imagineering filed a Disclaimer of Patent under 35 U.S.C. § 253 with the U.S. Patent and Trademark Office on March 5, 1993, stating, "Imagineering Inc. herewith disclaims and dedicates to the public the design patent claim for the entire term of the aforesaid United States Patent." App. *infra*, 53a, thereby placing the claimed design, (in which Imagineering was asserting trade dress), in the public domain under the patent laws.

On June 30, 1993, Imagineering first provided Van Klassens with a description of its alleged trade dress. The written description provided by Imagineering, in pertinent part, states:

> Plaintiff's trade dress consists of the overall impression created by the following not listed in any particular order:

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[1]Imagineering produced this evidence only after Van Klassens requested the deposition of Imagineering's patent counsel who had taken over the prosecution of the rocking chair patent application and had prosecuted it to issuance. Imagineering's response to this request for discovery was to argue ***ex parte*** to the district court that the deposition should not be allowed, see App. *infra*, 11a, and to disclose to the district court the existence of the "on-sale bar".

- use of only prime grade mahogany and teak, such as Honduras mahogany
- superior finishing, utilizing AWLGRIP® paint, particularly white
- utilization of boat building techniques, such as reinforcing joints with Gougeon epoxy using the WEST SYSTEM®
- curved and/or nautical lines to the furniture
- marine epoxy applied to bottoms of the legs together with pads or gliders
- smooth, high gloss appearance due to extensive hand sanding
- mahogany pieces offered in clear coat AWLGRIP®, high gloss white AWLGRIP® (which is stressed), or custom colors
- brass rectangular nameplate, located on the back rail or apron of the furniture
- mortise and tenon joinery
- multiple coats of primer and AWLGRIP® with hand sanding in between each application
- built by highly skilled artisans dedicated and trained in the finest traditions of furniture manufacturing
- photographic composition of advertisements and angles at which the furniture is advertised
- The overall appearance of the furniture both individually and in combination with other pieces, such as:

1) Isleboro Dining Table - a rounded table having 4 tapered legs, a solid apron, a table top having a solid apron, a table top having a solid outer rim with an inner slatted region, available in regular or cocktail sizes

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4) Jackson Chair - having notched front leg members, a slatted backrest, slatted and scooped seat boards, a winged crest rail, tapered arm rests, leg support members, a rearwardly angled backrest

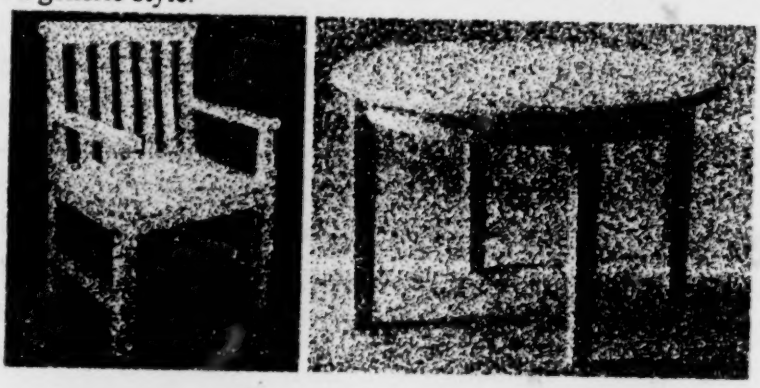
***

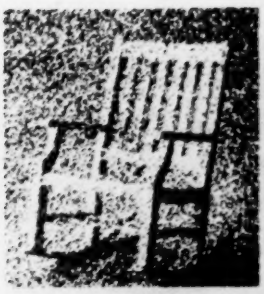
11) Dark Harbor Rocker - having notched front leg members, an angled backrest, tapered arm rests, leg support members, advertisement of and lack of a crazy spot, slatted backrest with the back slats terminating above the seat, scooped and slatted seatboards, a curved backrest

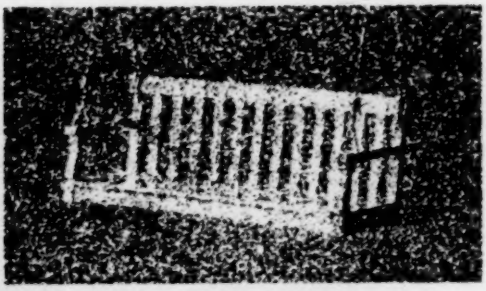
12) South Harbor Chaise Lounge - brass elevator and components, solid white wheels having counter sunken bolts and marine grade non-skid stripping, adjustable backrest, advertised with flat-ribbed sail cloth cushions. available with or without arms, tapered armrests with notched support and slats

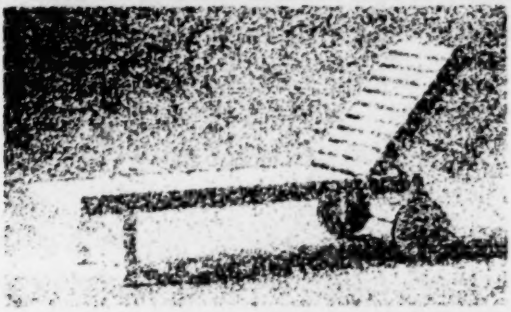
13) Weatherend Swing - having notched from armrest support member, slatted backrest, slatted seatboards, tapered arms, nautical crest rail, angled backrest.

As can be seen by a comparison of the overall appearance of Imagineering's Jackson Chair, Isleboro dining table, Dark Harbor Rocking Chair, Weatherend Swing and Southern Harbor Chaise Lounge, illustrated below, there is an absence of an identifiable trade dress common to Imagineering's line of furniture, which is separate from a generic style.









The overall appearance of these products is different, and the pieces cannot reasonably be viewed as having a common trade dress separate from the style. In fact, as discussed more fully hereinbelow, a majority of these pieces lack anything in common save "wooden slats". Moreover, any features common to each piece of furniture are in the public domain by operation of the patent laws.

Van Klassens maintained throughout trial that it had not copied Imagineering's furniture, that it had independently designed its own furniture out of a desire to produce the same style of furniture seen in Scotland and England. Any similarity between the two competing lines of furniture resulted from the fact that both were the same generic style of furniture. After a three week trial that began on October 27, 1993, the jury reached a verdict on November 15, 1993 finding for Imagineering on its claim of inherently distinctive trade dress, its trade dress infringement claims and false advertising claims.[2] Imagineering dismissed its dilution claim after trial. App.

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[2]While not addressed by the Federal Circuit, Van Klassens asserted on appeal that the jury was improperly charged on the issue of functionality and, improperly, was not given a charge on the asserted genericness of the trade dress.

infra, 20a. Approximately 4 months later, the court entered an Opinion denying Van Klassens' defense of laches. App. *infra*, 30a. On April 4, 1994, the court entered its Final Order and Permanent Injunction. App. *infra*, 20a-23a. On motion by Van Klassens, the Federal Circuit temporarily stayed the injunction, App. *infra*, 17a-18a, but subsequently lifted the stay. App. *infra*, 14a-16a.

Pursuant to the Final Order and Permanent Injunction, Imagineering was awarded, among other things, $4,000,000.00 in punitive damages. App. *infra*, 23a. The Federal Circuit ordered a discretionary remittitur of this amount finding it to be excessive. App. *infra*, 9a-10a.

Pursuant to the Final Order and Permanent Injunction, Van Klassens was enjoined from commercializing furniture which "embodies or resembles" Imagineering's furniture trade dress "as best set forth in Exhibit 'A'". Exhibit A is a collection of photographs of 22 pieces., including the pieces illustrated above, of Imagineering furniture, including tables, chairs, settees, benches, a rocking chair, a chaise lounge and a porch swing. On appeal to the Federal Circuit, the Federal Circuit affirmed the jury's finding that Imagineering's alleged trade dress was "inherently distinctive" and that there was a likelihood of confusion. Moreover, the Federal Circuit stated that the record evidence supported an inference of willful copying. App. *infra*, 7a-10a. Even if it is assumed that Van Klassens copied Imagineering's furniture, which it did not, Van Klassens contends that this is permissible under the patent laws. Further, the Federal Circuit affirmed the District Court's injunction prohibiting Van Klassens from making and selling a furniture design that is unpatented and unpatentable.

Imagineering has succeeded in obtaining through trade dress what it could never have obtained through the patent laws: an unfettered, permanent monopoly over a line of wooden slatted furniture. The failure of the district court and the Federal Circuit to recognize that federal patent law creates a right to copy public domain furniture has resulted in a patent-like monopoly for Imagineering. Moreover, the Federal Circuit ignored this Court's

clear precedent, as well as its own precedent, when it upheld an award of punitive damages for nothing more than the copying of Imagineering's unpatented and unpatentable furniture designs. The uniform system of design patent protection, and the public's right to copy designs not protected by design patents, are frustrated by the inconsistent and conflicting decisions in the judicial circuits. The failure of many of the judicial circuits to recognize and heed the distinctions between the policies of federal patent law and the Lanham Act in fashioning remedies has resulted in an obvious tension between these two bodies of law, namely the granting of patent-like remedies in clear violation of the important right to copy inherent in our system of patent laws.[3] As a result, manufacturers in the slatted, wooden furniture industry are no longer free to copy unpatented or unpatentable product designs for fear of exposing themselves to "trade dress" infringement litigation.[4] Van Klassens seeks review of this direct and irreconcilable conflict among the circuits regarding whether a party can make and sell the unpatented furniture designs of its competitor and whether or not that party can be held liable for compensatory and punitive damages for merely copying the unpatented furniture designs of its competitor.

REASONS FOR GRANTING THE PETITION

I. THE DECISION OF THE FEDERAL CIRCUIT IS IN DIRECT CONFLICT WITH THE DECISIONS OF OTHER CIRCUITS AND THIS COURT'S PRECEDENT.

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[3] "The *conflict* posed by these state laws and the Lanham Act remains the same: whether trademark can be used as a back door to protection properly acquired by a design patent." *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 647, n. 3 (7th Cir. 1993)(Cudahy, J. dissenting).

[4] "What is at stake here is the right to copy the thing itself -- that is to copy its configuration or design. The configuration or design of a product is as generic as the name of the product." *Kohler*, 12 F.3d at 647 (Cudahy, J. dissenting).

A. The injunction against selling the unpatented and unpatentable furniture configurations is in derogation of the "right to copy and use" inherent in federal patent law.

The decision of the Federal Circuit in affirming the district court's injunction enjoining Van Klassens from using Imagineering's trade dress in the unpatented and unpatentable configurations of its furniture is in conflict with this Court's clear precedent and is also in conflict with decisions of the United States Courts of Appeals for the Second Circuit and for the Third Circuit. *Compare Singer Mfg. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989); *Qualitex Co. v. Jacobson Products Co., Inc.*, 115 S.Ct. 1300 (1995); *Bose Corp. v. Linear Design Labs, Inc.*, 467 F.2d 304, 310 n. 7 (2d Cir. 1972); and, *Merchant & Evans Inc. v. Roosevelt Building Products Co.*, 963 F.2d 628 (3rd Cir. 1992).

The sweeping protection of Imagineering's entire line of Weatherend furniture, which includes furniture in various configurations, sizes and shapes, has the unacceptable effect of removing non-infringing design features from the market. *Coach Leatherware Co. v. AnnTaylor, Inc.*, 933 F.2d 162, 171 (2d Cir. 1991). Van Klassens has been enjoined from commercializing an entire style of furniture, which is in the public domain and that was advertised by Imagineering as being copied from a turn-of-the-century furniture builder. However, "[i]t is a first principle of trademark law that an owner may not use the mark as a means of excluding competition from a substantial market." *Wallace International Silversmiths v. Godinger Silver Art*, 916 F.2d 76 (2d Cir. 1990).

Beginning with *Singer Mfg v. June Mfg. Co.*, 163 U.S. 169 (1896), the Supreme Court has uniformly held that there is a federal

"right to copy" the subject matter of an expired patent. In *Singer*, the Court stated:

> It is self-evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent.

Singer, 163 U.S. at 185 (1896).

In *Sears, Roebuck & Co. v. Stiffel Company*, 376 U.S. 225 (1964), Stiffel had design and mechanical patents on a pole lamp. Sears copied Stiffel's pole lamp and sold a substantially identical copy. Stiffel sued Sears for patent infringement and unfair competition under Illinois state law. The district court found the patents to be invalid, but found a likelihood of confusion between the competing lamps and found Sears guilty of unfair competition, enjoined Sears from selling or attempting to sell pole lamps identical to or confusingly similar to Stiffel's lamps and awarded Stiffel damages. The court of appeals affirmed. This Court stated:

> [W]hen the patent expires the monopoly created by it expires, too, and the right to make the article -- including the right to make it in precisely the shape it carried when patented -- passes to the public.

Sears, 376 U.S. at 230. In the present case, Van Klassens has been held liable for making and selling furniture that is "confusingly similar" to Imagineering's furniture, one piece of which is the subject of an invalid patent disclaimed under 35 U.S.C. § 253 because of an "on-sale" bar. Van Klassens, like Sears, has been enjoined from commercializing furniture that embodies the trade dress of

Imagineering's furniture design. However, the design of Imagineering's rocking chair has been dedicated to the public. App. *infra*, 53a.

The rest of the twenty-two pieces of furniture are ineligible for patent protection having been commercially exploited for more than one year. See 35 U.S.C. §102. "An unpatentable article, like an article on which the patent has expired, is in the public domain and may be made and sold by whomever chooses to do so." *Sears*, 376 U.S. at 231. Further, this Court stated that:

> What Sears did was to copy Stiffel's design and to sell lamps almost identical to those sold by Stiffel. This it had every right to do under the federal patent laws. That Stiffel originated the pole lamp and made it popular is immaterial. "Sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all -- and in the free exercise of which the consuming public is deeply interested." [citing *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938)]
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> Sears has been held liable here for unfair competition because of a finding of likelihood of confusion based only on the fact that Sears' lamp was copied from Stiffel's lamp and that consequently the two looked exactly alike. ... But because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying.

Sears, 376 U.S. at 231-232.

Likewise in the *Sears* companion case, *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964), this Court stated that:

> A state of course has power to impose liability upon those who, knowing that the public is relying upon an original manufacturer's reputation for quality and integrity, deceive

> the public by palming off their copies as the original. That an article copied from an unpatented article could be made in some other way, that the design is "nonfunctional" and not essential to the use of either article, that the configuration of the article copied may have a "secondary meaning" which identifies the maker to the trade, or that there may be "confusion" among purchasers as to which article is which or as to who is the maker, may be relevant evidence in applying a State's law requiring such precautions as labeling; however, and regardless of the copier's motives, neither these facts nor any others can furnish a basis for imposing liability for or prohibiting the actual acts of copying and selling.

Compco., 376 U.S. at 238.

As stated above, Van Klassens maintained throughout trial that it had not copied Imagineering's furniture, that it had independently designed its own furniture out of a desire to produce the same type of furniture seen in Scotland and England, and that any similarity between the two competing lines of furniture resulted from the fact that both were the same generic style of furniture. This notwithstanding, the Federal Circuit stated that the record evidence supported an inference of willful copying. App. *infra*, 7a-10a. Even if it is assumed that Van Klassens copied Imagineering's furniture, this fact alone does not support an injunction prohibiting Van Klassens from making and selling the unpatented and unpatentable furniture designs at issue in this case. Even if it is assumed that Van Klassens copied Imagineering's furniture designs, "[t]his it had every right to do under the federal patent laws". *See Sears* 376 U.S. at 231.

In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), the Supreme Court reaffirmed this principle stating, "For almost 100 years it has been well established that in the case of an expired patent, the federal patent laws *do* create a federal right to 'copy and use.'" *Id.* at 165 (emphasis in original). Moreover, this Court reaffirmed that Article I, §8, cl. 8, of the U.S. Constitution

contains not only a grant of Congressional power, but also limitations upon the exercise of that power, stating:

> Congress may not create patent monopolies of unlimited duration, nor may it "authorize the issuance of patents whose effects are to **remove existent knowledge from the public domain**, or to **restrict free access to materials already available**." *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 6 (1966).

Bonito Boats, 489 U.S. at 146 (emphasis added). The Federal Circuit's affirmance of a grant of a patent-like monopoly on twenty-two separate pieces of furniture has the improper effect of removing existent knowledge from the public domain and restricting free access to materials already available. Accordingly, it should not stand.[5]

In *Qualitex Co. v. Jacobson Products Co., Inc.*, 115 S.Ct. 1300 (1995), the Court reaffirmed that "It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§154, 173, after which competitors are free to use the innovation." *Id.* at 1304. In *Hubbell Inc. v. Pass & Seymour, Inc.*, 94 Civ. 7631 (RWS) (SDNY May 18, 1995), the Southern District of New York dismissed this language, and the language that followed, as "dicta" and said that this language was not inconsistent with the proposition that the expiration of a design patent does not preclude a party from seeking to protect its reputation or avoid consumer confusion over products if it can demonstrate the elements of a

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[5]There are at least two cases presently pending in the federal courts as a direct result of the judgments in the present case. In *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co., Inc. et al.*, 95-CV-492 (FJS) (N.D.N.Y.), the defendants have been preliminarily enjoined from selling a style of furniture popularized at the turn of the century. In *Landscape Forms, Inc. v. Columbia Cascade Company*, App. No. 95-7343 (2nd Cir. 1995) the defendant is seeking review of a preliminary injunction that prohibits the defendant from selling the unpatented design of a park bench. The plaintiff in each case is represented by Imagineering's trial counsel.

Lanham Act, or other nonconflicting unfair competition, claim. Whether the Lanham Act allows a party to protect its reputation or avoid consumer confusion is not the issue. Each party clearly labels its products and advertisements with its own source-indicative trademark. What is at stake is whether that party can obtain perpetual patent-like protection, through the guise of trade dress, over a an entire line of furniture designs.

In *Merchant & Evans Inc. v. Roosevelt Building Products, Inc.*, 963 F.2d 628 (3rd Cir. 1992), the Third Circuit Court of Appeals, (hereinafter, "the Third Circuit"), examined the apparent tension between the federal right to copy and use embodied in the patent laws and the Lanham Act as applied to trade dress in product configurations. The Third Circuit quoted this Court's admonition that:

> First, patent law seeks to foster and reward invention; second, it promotes disclosure of inventions to stimulate further innovation and to permit the public to practice the invention once the patent expires; third, the stringent requirements for patent protection seek to assure that ideas in the public domain remain there for free use of the public.

Merchant & Evans, 963 F.2d at 639 (quoting *Aronson v. QuickPoint Pencil Co.*, 440 U.S. 257 (1979). For the rationale behind federal trademark protection, the Third Circuit again looked to this Court's opinion in *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985). The Third Circuit quoted this Court stating:

> The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers. National protection of trademarks is desirable, Congress concluded because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.

Merchant & Evans, 963 F.2d at 639. Under the patent laws, inventors disclose new, original and ornamental designs for articles of manufacture and in exchange for this disclosure, the patent laws grant the inventor a monopoly for up to fourteen years, after which the design passes into the public domain. *See, e.g., Singer Mfg. Co.*, 163 U.S. at 185 and 35 U.S.C. §§171, 173. The Third Circuit recognized that if "trademark law could be used to extend that monopoly indefinitely upon expiration of a patent, the compromise struck by the patent laws would be thwarted." *Merchant & Evans*, 963 F.2d at 639. Because the purpose of trademark law is to prevent confusion, and not to afford a monopoly to the markholder, the Third Circuit stated that "in general, there is no need to stop the production and distribution of the accused products altogether." *Id.*

In the present case, the Federal Circuit affirmed an injunction that absolutely prohibits Van Klassens from using Imagineering's unpatented and unpatentable furniture designs. One of the pieces in Imagineering's line of furniture is its rocking chair which was the subject of the invalid '320 patent. Imagineering has dedicated the design of this patent to the public. Nevertheless, Imagineering claims that the public is not free to use this design because it now constitutes Imagineering's trade dress. This injunction should not be allowed to stand. As this Court has stated "imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy". *Bonito Boats*, 489 U.S. at 146. The injunction against making products which resemble Imagineering's unpatented and unpatentable furniture designs, which under the patent laws are freely available to the public, impermissibly interferes with the federal policy found in Art. I, §8, cl. 8, of the Constitution, and in the implementing federal statutes, of allowing free access to copy whatever the patent laws leave in the public domain. *Compare Compco*, 376 U.S. at 237.

Clearly consumers have a right to be protected from *confusion as to source* and this is the focus of the Lanham Act. While this focus may result in the creation of "quasi-property rights" in communicative symbols, *see, e.g., Bonito Boats*, 489 U.S. at 157,

the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation.

Of course, it should be noted that *Compco* states that a design may be copied at will if it is "not entitled to a design patent or other federal statutory protection." *Compco*, 376 U.S. at 238. Perhaps, as a result of this reference to "other federal statutory protection," Section 43(a) has been interpreted to create a Federal law of unfair competition. *See* John B. Pegram, *Trademark Protection of Product and Container Configurations*, 81 Trademark Reporter 1, 7-9 (1991).[6] However, in *Bonito Boats*, when this Court reaffirmed the principles behind *Sears* and *Compco*, this Court apparently omitted reference to "other Federal statutory protection". *See Bonito Boats*, 489 U.S. at 153-156. Moreover, this Court took a narrow view of unfair competition law's ability to exclude use of a product configuration and quoted Judge Hand favorably where he wrote:

> [T]he plaintiff has the right not to lose his customers through false representations that those are his wares which in fact are not, but he may not monopolize any design or pattern, however trifling. The defendant, on the other hand, may copy plaintiff's goods slavishly down to the minutest detail: but he may not represent himself as the plaintiff in their sale.

Bonito Boats, 489 U.S. at 157 (quoting *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299, 301 (2 Cir. 1917); *see also* Pegram, *supra* at p. 20. In the instant case, both parties clearly label their products and advertising to indicate the furniture's source.

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[6] "[I]n practice, the federalization of trademark law under the Lanham Act appears to have made a successful end run around *Sears/Compco*." Jay Dratler Jr., *Trademark Protection for Industrial Design*, 1988 U. Ill. L. Rev. 887, 923.

B. The assessment of punitive damages under state unfair competition law for selling furniture that is similar to Imagineering's unpatented and unpatentable furniture configurations is in derogation of the "right to copy and use" inherent in federal patent law.

In addition to being enjoined from commercializing the unpatented and unpatentable furniture designs at issue in this case, punitive damages under New York state law were assessed against Van Klassens. While the Federal Circuit vacated the amount as excessive, it affirmed the award of punitive damages. This was contrary to the holdings of this Court in *Sears* and *Compco* and was also in conflict with controlling Second Circuit authority. As stated above, Imagineering's alleged trade dress resides in the three dimensional design of its furniture. These products have either been the subject matter of an invalid design patent, or are now ineligible for patent protection by operation of 35 U.S.C. § 102. In *Litton System, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1448 (Fed. Cir. 1984), a case where a state unfair competition action was based upon the copying of a three dimensional design subject to design patent protection, the Federal Circuit stated:

> [T]he district court should have considered a preliminary jurisdictional question. The district court, in this case, erred in reaching any element of the state causes of action. The district court should have disposed of these actions, that is, in view of the preemption doctrine as applied in Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) ("[B]ecause of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying." Id. at 232.), and Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964).
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> * * *

> . . . The key to determining whether the Sears and Compco cases prohibit a state action is whether a design is of the type on which a patent may issue.

(emphasis added). Any award of punitive damages is preempted by federal patent law and should have been vacated.

Whereas the Federal Circuit had jurisdiction over the appeal, App. *infra*, 4a, preemption should have been decided with reference to the law of the regional circuit. *Power Lift, Inc. v. Weatherford Nipple-Up Sys., Inc.*, 871 F.2d 1082 (Fed. Cir. 1989). Thus, Second Circuit law controlled the question of what remains to the state under unfair competition in the circumstances of this case. The Second Circuit has stated that:

> The copying of an unpatented machine, even if it caused the public to be confused as to source rather than product would afford relief for unfair competition that would "go no further than to require the defendant to make plain to buyers that the plaintiff was not the source of the machines sold by it." Modern Aids, Inc. v. R. H. Macy & Co., 264 F.2d 93, 94 (2 Cir. 1959).

Bose Corp. v. Linear Design Labs, Inc., 467 F.2d 304, 310 n. 7 (2d Cir. 1972).

Accordingly, in the case at bar preemption should have limited the Court's subject matter jurisdiction over Imagineering's state unfair competition claim to a remedy which went "no further than to require [Van Klassens] to make plain to buyers that [Imagineering] is not the source of the [furniture] sold by it." *Id.* Thus, an award of punitive damages under Imagineering's state unfair competition claim was improper and should be vacated as a matter of law. Accordingly, the judgment should be vacated.

II. THE CONSISTENT NATIONAL SCHEME OF PATENT PROTECTION IS IMPAIRED BY THE DECISION OF THE FEDERAL CIRCUIT.

As stated above, this case is about an alleged trade dress in the configuration of numerous pieces of furniture in a line of furniture. Thus, this is a trade dress in a product configuration case. This case is not about distinctive packaging, product containers or distinctive labeling. The Federal Circuit noted that Imagineering's trade dress consisted of "a nautical look, with wide slats, scooped seat boards and arms, rounded edges, notched and curved legs, and angled backrests." App. *infra*, 2a. These elements are not common to all of the individual pieces of furniture in Imagineering's line of furniture. More importantly, these are not arbitrary embellishments adopted to identify Imagineering's furniture. Instead, these are elements that are necessary to compete in the free market for this style of furniture.[7] This Court recognized in *Qualitex* that:

> [I]f a design's "aesthetic value" lies in its ability to "confe[r] a significant benefit that cannot practically be duplicated by the use of alternative designs," then the design is "functional." Restatement (Third) of Unfair Competition §17, Comment c. pp. 175-176 (1995). The "ultimate test of aesthetic functionality," it explains, "is whether the recognition of trademark rights would significantly hinder competition." *Id.* at 176.

115 S.Ct. at 1306. Granting Imagineering trademark rights in "a nautical look, with wide slats, scooped seat boards and arms, rounded edges, notched and curved legs, and angled backrests", App. *infra*,

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[7]It was disputed at trial whether this style was properly characterized as "English Garden Furniture" or "Arts and Crafts". For purposes of this petition, it matters not what the proper name of the style is, as long as it is recognized that slatted seats, slatted backrests, etc. are necessary to compete in this style.

2a, will not merely hinder competition, it will eliminate competition in this commonplace style of furniture.

Moreover, elements in the design of the furniture that are common to the line are embodied in Imagineering's rocking chair '320 patent which was dedicated to the public by Imagineering. For the Court's convenience, and as a point of reference, Figure 4 of the '320 patent is set forth below[8]:

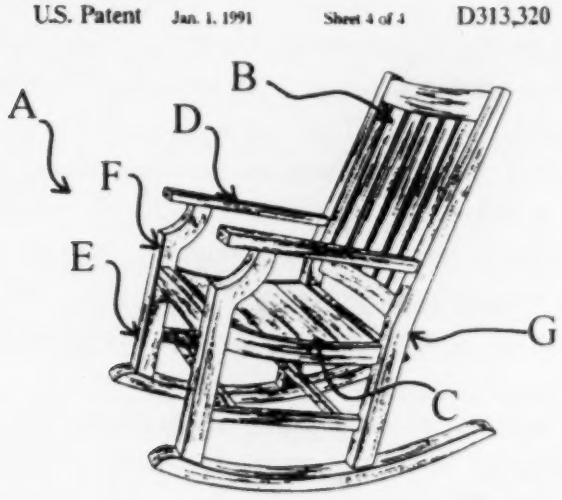

FIG. 4

As can be seen, Imagineering's rocking chair, illustrated above has a nautical[9] look **A**[10], wide slats **B**, scooped seat boards **C**, and arms **D**, rounded edges **E**, notched and curved legs **F**, and an angled

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[8]Alphabetic reference indicators and lead lines have been added to show the monopolized trade dress elements which correspond with the design patent elements dedicated to the public under 35 U.S.C. § 253.

[9]While petitioners respectfully assert that "nautical look" is vague, to the extent that it is common to the line, App. *infra*, 2a, it is embodied in the rocking chair.

[10]Alphabetic reference characters refer to the reference characters in the illustration of Figure 4 of the '320 patent, *supra*.

backrest **G**. As stated above, these are the elements that the Federal Circuit noted that the pieces shared. App. *infra*, 2a. If the trade dress is said to reside in the overall design of the individual pieces of furniture, rather than some arbitrary, source-indicating, embellishment, then that design has been dedicated to the public under 35 U.S.C. § 253 and Imagineering should not as a matter of law be heard to claim it as its trademark. A design that has been dedicated to the public is free for the public to use and as a matter of law cannot serve as an indicator of source. As this Court noted in *Qualitex*, "it is the source-distinguishing ability of a mark – not its ontological status of color, shape, fragrance, word, or sign – that permits it to serve these basic purposes." 115 S.Ct. at 1304.

The Federal Circuit relied on this Court's opinion in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S.Ct. 2753 (1992) for the proposition that inherently distinctive trade dress qualifies for protection from infringement. App. *infra*, 5a. However, the Federal Circuit did not consider whether Imagineering's trade dress in the shape of its furniture could be inherently distinctive, *i.e.* able to identify the particular source of the product by its "intrinsic" nature, *id.*, in view of the dedication of the design of the furniture to the public by operation of the patent laws. Moreover, the trade dress at issue in *Two Pesos*, involved the decor of a restaurant, which is more analogous to trade dress in the packaging and labeling of a product rather than in the shape of the product itself.

While the Federal Circuit affirmed the jury's finding that Imagineering's trade dress is inherently distinctive,[11] it has been noted in past decisions that trade dress in a product's shape is never inherently distinctive. *See, e.g., Kohler*, 12 F.3d at 641 n. 11 ("... a products shape is never inherently distinctive" citing a collection of cases in *McCarthy on Trademarks* § 7.23[2]).[12] There was no survey

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[11] That is, having the ability to "almost *automatically*" tell Imagineering's customers that it "refers to a brand." *See Qualitex*, 115 S.Ct. 1303.

[12] "Unlike verbal marks, industrial designs do not describe anything, they just are." Dratler, *supra*, at 903.

evidence that any number of potential consumer's recognized or relied on any source-indicating qualities of the alleged trade dress. Further, Imagineering did not adopt its design to be an indicator of source. "[William Fisher] had one express intent in founding the company: to **recreate**, in all its fineness of detail, the fabulous furniture he discovered at the [Weatherend] estate." Imagineering affixes a brass plaque to its furniture as an indicator of source, "a sign of assurance - a guarantee that your piece is genuine Weatherend® Estate Furniture..."

Moreover, if a product's color is not "inherently distinctive" and must rely upon acquired distinctiveness, i.e. secondary meaning, *see Qualitex*, 115 S.Ct. at 1303, how then can a product's shape be said to be inherently distinctive. In this regard, in *Qualitex*, this Court stated:

> True, a product's color is unlike "fanciful," "arbitrary," or "suggestive" words or designs, which almost *automatically* tell a customer that they refer to a brand. The imaginary word "Suntost," or the words "Suntost Marmalade," on a jar of orange jam immediately would signal a brand or a product "source"; the jam's orange color does not do so. But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm's insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods ... .

115 S.Ct. at 1303 (emphasis in original). It is equally true that a product's shape is unlike "fanciful", "arbitrary", or "suggestive" words or designs, which "almost *automatically* tell a customer that they refer to a brand." *Id.* Even if one were to assume that Imagineering's trade dress in the shape of its furniture could be said to be inherently distinctive, under this Court's holdings in *Sears*,

Compco, and *Bonito Boats*, a court could still not properly enjoin the making and selling of similar furniture products.

In order to constitute a recognizable trade dress, Imagineering's trade dress had to be identifiable and common to all of the pieces of furniture alleged to have been infringed. In this regard, in *Walt Disney Co. v. Goodtimes Home Video Corp.*, 830 F.Supp. 762 (SDNY 1993), the plaintiff also claimed trade dress in a line of products. However, the Southern District of New York noted that:

> . . . Disney has a burden which most plaintiffs alleging trade dress infringement do not need to carry. Disney must establish the existence of a recognizable trade dress. That is, Disney must establish that its videocassette packages have a consistent overall look.

Id. at 766. And, the court found that there was not a protectable trade dress stating that:

> [w]hile there are similar packaging features, . . . these similarities, **in light of the differences** . . ., are not sufficient to give the packages an identifiable trade dress.

Id. at 768 (emphasis added). Thus, where trade dress is claimed as to a line of products, plaintiff must show that the trade dress is made up of features which are common to each of the pieces in the line. Even where there are similarities in the pieces in the line, the similarities, in light of the differences, must give rise to an identifiable trade dress shared by all pieces in the line. Imagineering's furniture line does not have a consistent overall look. While there may be similarities in the "nautical look" and in the construction methods, these similarities, in light of the differences, are not sufficient to give the line of furniture an identifiable trade dress. *See also, Harlequin Enters. Ltd. v. Gulf & Western Corp.*, 644 F.2d 946 (2d Cir. 1981). Indeed, in *Harlequin Enters. Ltd.*, both the

district court and the Second Circuit deemed the trade dress to reside only in features common to each book cover in the line. The district court in *Walt Disney Co.* noted that "[u]nlike the package at issue in *Harlequin*..., the format of each of Disney's videocassette packages is different." 830 F.Supp. at 767. While both *Walt Disney* and *Harlequin Enters. Ltd.* are product packaging or labeling cases, it is even clearer that for a trade dress in a product configuration to extend across a line of products, the trade dress must reside only in features common to each product.

In the case at bar, Imagineering alleged that it owned a trade dress common to the 22 pieces of furniture in its line. The absence of any such identifiable trade dress common to Imagineering's line of furniture is clearly illustrated by a comparison of the overall appearance of Imagineering's Isleboro dining table, and Imagineering's Jackson chair, illustrated *supra*. The overall appearance of these two products is totally different, and the pieces cannot reasonably be viewed as having a common trade dress.

More significantly, a review of the photographs attached to the district court's injunction as "Exhibit A", reveals that few, if any, features of Imagineering's furniture can be found in every piece. Imagineering furniture is offered painted or with a natural finish. Even among the painted pieces, a variety of colors are used. In addition, while a "high gloss finish" is identified as a trade dress feature, the teak pieces do not have a high gloss finish. The Federal Circuit stated that Imagineering's line shared a common trade dress and stated that "[t]he twelve pieces of furniture in the WEATHEREND line all share a nautical look, with wide slats, scooped seat boards and arms, rounded edges, notched and curved legs, and angled backrests." App. *infra*, 2a. However, the Federal Circuit only considered twelve of the twenty-two pieces of furniture that are the subject of the injunction. Further, this definition of the trade dress does not withstand comparison with Imagineering's own written description. For example: Imagineering's swing does not have "scooped seat boards", or "notched and curved legs"; Imagineering's chaise lounges do not have "scooped seat boards" or

"notched and curved legs"; neither of the five differently configured tables in the injunction have "scooped seat boards and arms", "notched and curved legs" or "angled backrests"; . As can be seen, the majority of the pieces in the WEATHEREND line lack anything in common save the vague notion of "a nautical look". One piece of furniture in the WEATHEREND line that incorporates each of these design elements is the rocking chair. Of course the design of the rocking chair has been dedicated to the public. App. *infra*, 53a.

The only thing thematically consistent in the WEATHEREND line is that the pieces are of the same style. Imagineering should not be allowed exclusive rights under the Lanham Act to a style of furniture long known in the industry and which is aesthetically functional. The effect of the injunction is to impede competition in the industry for this style of furniture or even for furniture with a "nautical look". The purpose of the Lanham Act is not to shield Imagineering from competition in this style of furniture.[13] Yet, that is precisely the effect of the injunction.

In *Wallace International Silversmiths v. Godinger Silver Art*, 916 F.2d 76 (2d Cir. 1990), the Second Circuit stated:

> [W]e are confident that whatever secondary meaning Wallace's baroque silverware pattern may have acquired, Wallace may not exclude competitors from using those baroque design elements necessary to compete in the market for baroque silverware. It is a first principle of trademark

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[13]The purpose of the Lanham Act is to protect consumers from confusion. *See, e.g., Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. at 198. While the Federal Circuit affirmed a finding of a likelihood of confusion, it is important to note that after six years of unrestrained competition, Imagineering was unable to present evidence of even a single instance in which a consumer purchased Van Klassens furniture believing it to be Imagineering furniture. Nor did Imagineering present any survey evidence on the issue of confusion. Moreover, this Court has stated that confusion cannot furnish a basis for prohibiting the actual acts of copying and selling unpatented and unpatentable products. *See, generally, Sears* and *Compco, supra*.

> law that an owner may not use the mark as a means of excluding competitors from a substantial market.
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> In the instant matter, Wallace seeks trademark protection, not for a precise expression of a decorative style, but for basic elements of a style that is part of the public domain. As found by the district court, these elements are important to competition in the silverware market. We perceive no distinction between a claim to exclude all others from use on silverware of basic elements of a decorative style and claims to generic names, basic colors or designs important to a product's utility. In each case, trademark protection is sought, not just to protect an owner of a mark in informing the public of the source of its products, but also to exclude competitors from producing similar products.

Wallace, 916 F.2d at 81.

The Federal Circuit's opinion affirming the district court's injunction restraining Van Klassens from commercializing this style of furniture excludes Van Klassens from the market for this style of furniture. Contrary to the Second Circuit's holding in *Wallace*, Imagineering has been given trademark protection, "not for a precise expression of a decorative style, but for basic elements of a style that is part of the public domain". Imagineering should not be granted a perpetual, patent-like monopoly over twenty-two pieces of furniture that lack a common, source-identifying trade dress. Further, the implications of this injunction extend beyond the parties to this action. Third party manufacturers of this style of furniture must view this injunction with no small amount of trepidation. Van Klassens and the industry remain uninformed as to what Imagineering considers its trade dress to be and as to the acts being restrained. The injunction is of questionable utility in defining the parameters of prohibited conduct. The injunction provides no notice to other competitors in this style of furniture as to how to design furniture in this style without infringing Imagineering's "trade dress".

Thus, it will have the undesirable effect of deterring competition in furniture that may bear some resemblance to products already in the market. *See e.g. Lon Tai Shingh Co. v. Koch + Lowy*, 19 USPQ2d 1081, 1110 (SDNY 1990).

Moreover, granting patent-like protection to products that are unpatented and unpatentable, and therefore in the public domain, frustrates the public policy of notice inherent in the patent laws. Given the lack of a common, recognizable trade dress in Imagineering's line and the lack of any description or definition of Imagineering's trade dress, Imagineering's competitors in the English garden furniture industry are left without guidance as to what Imagineering considers its property and are therefore unable to effectively compete without exposing themselves to the risk of "trade dress" litigation. The effect of this injunction is not only to shield Imagineering from competition from Van Klassens, but, likely, from an entire industry. Granting Imagineering exclusive rights in these unpatented and unpatentable furniture designs frustrates the policy of public notice in the patent laws. As this Court stated in *Bonito Boats*:

> The federal patent scheme provides a basis for the public to ascertain the status of the intellectual property embodied in any article in general circulation. Through the application process, detailed information concerning the claims of the patent holder is compiled in a central location. See 35 U.S.C. §111-114. The availability of damages in an infringement action is made contingent upon affixing a notice of patent to the protected article. 35 U.S.C. §287. The notice requirement is designed "for the information of the public," [citation omitted], and provides a ready means of discerning the status of the intellectual property embodied in an article of manufacture or design. The public may rely upon the lack of notice in exploiting shapes and designs accessible to all.

489 U.S. at 161-162. In the instant case, if the judgment of the Federal Circuit is allowed to stand, the ability of the public to readily discern the status of any intellectual property embodied in an article of manufacture or design will be irreparably impaired. The public will not be able to rely upon the lack of notice in order to exploit shapes and designs that the patent laws make accessible to all.

CONCLUSION

As this Court noted in *Bonito Boats*, Congress has, despite "sustained criticism," refused to "alter the patent protections presently available for industrial designs." 489 U.S. at 168. "It is for Congress to determine if the present system of design ... patents is ineffectual in promoting the useful arts in the context of industrial designs." *Id.* By offering "patent-like protection" for furniture designs "deemed unprotected under the present federal scheme" the Federal Circuit's affirmance of the injunction and award of compensatory and punitive damages "conflicts with the 'strong federal policy favoring free competition in ideas which do not merit patent protection.'" *Id.* For the reasons set forth above, a writ of certiorari should issue to review the judgment and opinion of the Federal Circuit.

Respectfully submitted

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